

This listing of claims will replace all prior versions, and listings, of claims in the application:

1 Claim 1 (currently amended): A method for use in an
2 environment including a client device and an ad server, the
3 method comprising:
4 a) accepting ~~document~~ information concerning a
5 document requested by the client device, the
6 information being sourced from an application on the
7 client device;
8 b) determining at least one ad relevant to content of
9 the document using at least the accepted ~~document~~
10 information; and
11 c) sending the at least one ad determined to the
12 client device.

1 Claim 2 (original): The method of claim 1 wherein the act
2 of determining at least one ad relevant to the content of
3 the document further uses at least ad relevance
4 information.

1 Claim 3 (original): The method of claim 2 wherein the ad
2 relevance information includes an ad concept.

1 Claim 4 (currently amended): The method of claim 1 wherein
2 the accepted ~~document~~ information is document relevance
3 information.

1 Claim 5 (currently amended): The method of claim 1 wherein
2 the accepted ~~document~~ information is at least one concept
3 of the content of the document.

1 Claim 6 (currently amended): The method of claim 1 wherein
2 the accepted ~~document~~ information is a document identifier.

1 Claim 7 (original): The method of claim 6 wherein the act
2 of determining at least one ad relevant to the content of
3 the document includes
4 i) using the document identifier to lookup
5 document content relevance information, and
6 ii) using the document content relevance
7 information to determine at least one ad relevant
8 to the content of the document.

1 Claim 8 (currently amended): The method of claim 1 wherein
2 the accepted ~~document~~ information includes document
3 content.

1 Claim 9 (original): The method of claim 1 wherein the
2 application is a content requesting and rendering
3 application.

1 Claim 10 (original): The method of claim 1 wherein the
2 application is a browser.

1 Claim 11 (original): The method of claim 1 wherein the
2 application is a browser plug-in.

1 Claim 12 (original): The method of claim 1 wherein the
2 application is a browser toolbar.

1 Claim 13 (original): A method for use in an environment
2 including a client device and a content-relevant ad server,
3 the method comprising:

4 a) receiving, by the client device, a requested
5 document including content;
6 b) submitting, by the client device, a request for at
7 least one content-relevant ad to the content-relevant
8 ad server;
9 c) receiving, by the client device, at least one
10 content-relevant ad, sourced by the content-relevant
11 ad server; and
12 d) rendering, by the client device, at least one of
13 the at least one content-relevant ad received.

1 Claim 14 (original): The method of claim 13 wherein the
2 request includes an identifier of the received document.

1 Claim 15 (original): The method of claim 13 wherein the
2 request includes content of the received document.

1 Claim 16 (original): The method of claim 13 wherein the
2 request includes concepts derived from the content of the
3 received document.

1 Claim 17 (original): The method of claim 13 further
2 comprising:
3 - extracting, by the client device, concepts from the
4 content of the received document,
5 wherein the request includes the concepts extracted by
6 the client device.

1 Claim 18 (original): The method of claim 13 wherein the act
2 of rendering, by the client device, at least one of the at
3 least one content-relevant ad received includes rendering

4 the at least one of the at least one content-relevant ad in
5 association with the content of the requested document.

1 Claim 19 (original): The method of claim 13 further
2 comprising:

3 e) rendering, by the client device, the content of
4 the document in a first window,
5 wherein the at least one of the at least one
6 content-relevant ad received is rendered in a second
7 window.

1 Claim 20 (original): The method of claim 19 wherein the
2 second window is rendered over, and at least partially
3 covers, the first window.

1 Claim 21 (original): The method of claim 19 wherein the
2 second window is rendered beneath the first window without
3 covering any part of the first window.

1 Claim 22 (original): The method of claim 19 wherein the
2 second window is rendered adjacent to the first window.

1 Claim 23 (original): The method of claim 13 wherein the
2 request for at least one content-relevant ad is generated
3 and sent by a browser application on the client device.

1 Claim 24 (original): The method of claim 23 wherein the at
2 least one of the at least one content-relevant ad received
3 is rendered by the browser application.

1 Claim 25 (original): The method of claim 13 wherein the
2 request for at least one content-relevant ad is generated
3 and sent by a browser plug-in on the client device.

1 Claim 26 (original): The method of claim 25 wherein the at
2 least one of the at least one content-relevant ad received
3 is rendered by the browser plug-in.

1 Claim 27 (original): The method of claim 13 wherein the
2 request for at least one content-relevant ad is generated
3 and sent by a browser toolbar on the client device.

1 Claim 28 (original): The method of claim 27 wherein the at
2 least one of the at least one content-relevant ad received
3 is rendered by the browser toolbar.

1 Claim 29 (currently amended): The method of claim 13
2 further comprising:
3 e) rendering content of the requested document,
4 wherein the act of rendering content of the requested
5 document is initiated before the act of submitting a
6 request submits the request.

1 Claim 30 (currently amended): The method of claim 13
2 further comprising:
3 e) rendering content of the requested document,
4 wherein the act of rendering content of the requested
5 document is completed before the act of submitting a
6 request submits the request.

1 Claim 31 (original): The method of claim 13 further
2 comprising:

3 e) rendering content of the requested document,
4 wherein the act of rendering content of the requested
5 document is initiated before the act of rendering at least
6 one of the at least one content-relevant ad received is
7 initiated.

1 Claim 32 (original): The method of claim 13 further
2 comprising:

3 e) rendering content of the requested document,
4 wherein the act of rendering content of the requested
5 document is completed before the act of rendering at least
6 one of the at least one content-relevant ad received is
7 initiated.

1 Claim 33 (original): The method of claim 13 wherein the act
2 of submitting a request for at least one content-relevant
3 ad to the content-relevant ad server occurs before a
4 request for the requested document.

1 Claim 34 (currently amended): The method of claim 13
2 wherein the act of submitting a request for at least one
3 content-relevant ad to the content-relevant ad server
4 occurs ~~substantially~~ concurrently with a request for the
5 requested document.

1 Claim 35 (original): The method of claim 13 further
2 comprising:

3 e) rendering, by the client device, the content of
4 the document in a browser window,
5 wherein the at least one of the at least one
6 content-relevant ad received is rendered in the browser
7 window.

1 Claim 36 (original): The method of claim 13 further
2 comprising:
3 e) rendering, by the client device, the content of
4 the document in a first part of a browser window,
5 wherein the at least one of the at least one
6 content-relevant ad received is rendered in a second part
7 of the browser window, wherein the second part of the
8 browser window shares no space with the first part of the
9 browser window.

1 Claim 37 (original): The method of claim 36 wherein the
2 second part of the browser window is a browser chrome part
3 of the browser window.

1 Claim 38 (original): The method of claim 36 wherein the
2 second part of the browser window is a browser toolbar.

1 Claim 39 (original): The method of claim 36 further
2 comprising:
3 f) rendering browser chrome in a third part of the
4 browser window.

1 Claim 40 (original): The method of claim 39 wherein the
2 third part of the browser window is arranged between the
3 first and second parts of the browser window.

1 Claim 41 (original): The method of claim 39 wherein the
2 second part of the browser window is arranged between the
3 first and third parts of the browser window.

1 Claim 42 (currently amended): Apparatus, for use in an
2 environment including a client device and an ad server, the
3 apparatus comprising:
4 a) an input for accepting ~~document~~ information
5 concerning a document requested by the client device,
6 information being sourced from an application on the
7 client device;
8 b) means for determining at least one ad relevant to
9 content of the document using at least the accepted
10 ~~document~~ information; and
11 c) means for sending the at least one ad determined
12 to the client device.

1 Claim 43 (original): The apparatus of claim 42 wherein the
2 means for determining at least one ad relevant to the
3 content of the document further uses at least ad relevance
4 information.

1 44 (original): The apparatus of claim 43 wherein the ad
2 relevance information includes an ad concept.

1 Claim 45 (currently amended): The apparatus of claim 42
2 wherein the accepted ~~document~~ information is document
3 relevance information.

1 Claim 46 (currently amended): The apparatus of claim 42
2 wherein the accepted ~~document~~ information is at least one
3 concept of the content of the document.

1 Claim 47 (currently amended): The apparatus of claim 42
2 wherein the accepted ~~document~~ information is a document
3 identifier.

1 Claim 48 (original): The apparatus of claim 47 wherein the
2 means for determining at least one ad relevant to the
3 content of the document includes
4 i) means for looking up document content
5 relevance information using the document
6 identifier; and
7 ii) means for determining at least one ad
8 relevant to the content of the document using the
9 document content relevance information.

1 Claim 49 (currently amended): The apparatus of claim 42
2 wherein the accepted ~~document~~ information includes document
3 content.

1 Claim 50 (original): The apparatus of claim 42 wherein the
2 application is a content requesting and rendering
3 application.

1 Claim 51 (original): The apparatus of claim 42 wherein the
2 application is a browser.

1 Claim 52 (original): The apparatus of claim 42 wherein the
2 application is a browser plug-in.

1 Claim 53 (original): The apparatus of claim 42 wherein the
2 application is a browser toolbar.

1 Claim 54 (original): Apparatus, residing on a client
2 device, for use in an environment including a
3 content-relevant ad server, the apparatus comprising:

4 a) means for submitting a request for at least one
5 content-relevant ad to the content-relevant ad server;
6 b) an input for receiving
7 i) a requested document including content, and
8 ii) at least one content-relevant ad, sourced by
9 the content-relevant ad server; and
10 c) means for rendering at least one of the at least
11 one content-relevant ad received.

1 Claim 55 (original): The apparatus of claim 54 wherein the
2 request includes an identifier of the received document.

1 Claim 56 (original): The apparatus of claim 54 wherein the
2 request includes content of the received document.

1 Claim 57 (original): The apparatus of claim 54 wherein the
2 request includes concepts derived from the content of the
3 received document.

1 Claim 58 (original): The apparatus of claim 54 further
2 comprising:
3 - means for extracting concepts from the content of
4 the received document,
5 wherein the request includes the concepts extracted by
6 the client device.

1 Claim 59 (original): The apparatus of claim 54 wherein the
2 means for rendering at least one of the at least one
3 content-relevant ad received renders the at least one of
4 the at least one content-relevant ad in association with
5 the content of the requested document.

1 Claim 60 (original): The apparatus of claim 54 further
2 comprising:
3 e) means for rendering the content of the document in
4 a first window,
5 wherein the at least one of the at least one
6 content-relevant ad received is rendered in a second
7 window.

1 Claim 61 (original): The apparatus of claim 60 wherein the
2 second window is rendered over, and at least partially
3 covers, the first window.

1 Claim 62 (original): The apparatus of claim 60 wherein the
2 second window is rendered beneath the first window without
3 covering any part of the first window.

1 Claim 63 (original): The apparatus of claim 60 wherein the
2 second window is rendered adjacent to the first window.

1 Claim 64 (original): The apparatus of claim 54 wherein the
2 means for submitting the request for at least one
3 content-relevant ad is a browser application on the client
4 device.

1 Claim 65 (original): The apparatus of claim 64 wherein the
2 means for rendering is the browser application.

1 Claim 66 (original): The apparatus of claim 54 wherein the
2 means for submitting the request for at least one
3 content-relevant ad is a browser plug-in on the client
4 device.

1 Claim 67 (original): The apparatus of claim 66 wherein the
2 means for rendering is the browser plug-in.

1 Claim 68 (original): The apparatus of claim 54 wherein the
2 means for submitting the request for at least one
3 content-relevant ad is a browser toolbar on the client
4 device.

1 Claim 69 (original): The apparatus of claim 68 wherein the
2 means for rendering is the browser toolbar.

1 Claim 70 (currently amended): The apparatus of claim 54
2 further comprising:
3 e) means for rendering content of the requested
4 document,
5 wherein the means for rendering initiates rendering
6 content of the requested document before the means for
7 submitting submits the a request.

1 Claim 71 (currently amended): The apparatus of claim 54
2 further comprising:
3 e) means for rendering content of the requested
4 document,
5 wherein the means for rendering completes rendering
6 content of the requested document before the means for
7 submitting submits the a request.

1 Claim 72 (original): The apparatus of claim 54 further
2 comprising:
3 e) means for rendering content of the requested
4 document,

5 wherein the rendering of content of the requested
6 document is initiated before the rendering of at least one
7 of the at least one content-relevant ad received is
8 initiated.

1 Claim 73 (original): The apparatus of claim 54 further
2 comprising:

3 e) means for rendering content of the requested
4 document,

5 wherein the rendering of content of the requested
6 document is completed before the rendering of at least one
7 of the at least one content-relevant ad received is
8 initiated.

1 Claim 74 (original): The apparatus of claim 54 wherein the
2 submission of a request for at least one content-relevant
3 ad to the content-relevant ad server occurs before a
4 request for the requested document.

1 Claim 75 (currently amended): The apparatus of claim 54
2 wherein the submission of a request for at least one
3 content-relevant ad to the content-relevant ad server
4 occurs ~~substantially~~ concurrently with a request for the
5 requested document.

1 Claim 76 (original): The apparatus of claim 54 further
2 comprising:
3 e) means for rendering the content of the document in
4 a browser window,
5 wherein the at least one of the at least one
6 content-relevant ad received is rendered in the browser
7 window.

1 Claim 77 (original): The apparatus of claim 54 further
2 comprising:
3 e) means for rendering the content of the document in
4 a first part of a browser window,
5 wherein the at least one of the at least one
6 content-relevant ad received is rendered in a second part
7 of the browser window, wherein the second part of the
8 browser window shares no space with the first part of the
9 browser window.

1 Claim 78 (original): The apparatus of claim 77 wherein the
2 second part of the browser window is a browser chrome part
3 of the browser window.

1 Claim 79 (original): The apparatus of claim 77 wherein the
2 second part of the browser window is a browser toolbar.

1 Claim 80 (original): The apparatus of claim 77 further
2 comprising:
3 f) means for rendering browser chrome in a third part
4 of the browser window.

1 Claim 81 (original): The apparatus of claim 80 wherein the
2 third part of the browser window is arranged between the
3 first and second parts of the browser window.

1 Claim 82 (original): The apparatus of claim 80 wherein the
2 second part of the browser window is arranged between the
3 first and third parts of the browser window.

REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims comply with 35 U.S.C. § 112, are not anticipated under 35 U.S.C. § 102 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.

The applicants will now address each of the issues raised in the outstanding Office Action. Before doing so, however, the undersigned would like to thank Primary Examiner Rimell for courtesies extended during a telephone interview on August 8, 2006 ("the telephone interview"). During the telephone interview, the present invention was discussed, and the Merriman patent was discussed with respect to claims 1, 7 and 13.

Rejections under 35 U.S.C. § 112

Claims 29, 30, 70 and 71 are rejected under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter which applicants regard as their invention. The previous Examiner contended that in these claims, it is not clear as to what request is being submitted before the rendering of the document content.

The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the clarifying amendments to claims 29, 30, 70 and 71.

Claims 34 and 75 are rejected under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter which applicants regard as their invention. The previous Examiner contended that the use of the term "substantially" renders these claims invalid. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the clarifying amendments to claims 34 and 75.

Rejections under 35 U.S.C. § 102

Claims 1-19, 23-32, 35-38, 42-60, 64-73 and 76-79 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,948,061 ("the Merriman patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

During the telephone interview, Examiner Rimell indicated that he did not agree with all aspects of the previous Examiner's Office Action, and he felt that dependent claim 7 and independent claim 13 were allowable over the Merriman patent. Apparatus claims 48 and 54 correspond to method claims 7 and 13, respectively, and are therefore similarly allowable over the Merriman patent. Further, since claims 14-19, 23-32 and 35-38 depend, either directly or indirectly, from claim 13, and since claims 55-60, 64-73 and 76-79 depend, either directly or indirectly, from claim 54, these claims are similarly patentable over the Merriman patent.

Regarding independent 1, however, Examiner Rimell indicated that he felt that the Merriman patent anticipated claim 1 because the message 23 generated by the client device (instead of the page loaded into the client device) can be characterized as the claimed document. Examiner Rimell contrasted this with act (a) of claim 13 in which the document is received by the client device.

Claim 1 has been amended to recite a method for use in an environment including a client device and an ad server, the method comprising (a) accepting information concerning a *document requested by the client device*, the information being sourced from an application on the client device, (b) determining at least one ad relevant to content of the document using at least the accepted information, and (c) sending the at least one ad determined to the client device. Claim 1, as amended, precludes the characterization of the message 23 generated by the client device in the Merriman patent as the claimed document. Thus, independent claim 1 is not anticipated by the Merriman patent for at least this reason. Since apparatus claim 42 has been similarly amended, it is similarly not anticipated by the Merriman patent.

Since claims 2-12 depend, either directly or indirectly, from claim 1, and since claims 43-53 depend, either directly or indirectly, from claim 42, these claims are similarly not anticipated by the Merriman patent.

Rejections under 35 U.S.C. § 103

Claims 20-22 and 61-63 are rejected under 35 U.S.C. § 103(a) as being unpatentable the Merriman patent. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The previous Examiner conceded that the Merriman patent does not show the rendering location of an ad window relative to the content of a document, such as Web page window location. (See Paper No. 20050722, page 7.) To compensate for this deficiency, the previous Examiner argued that it would have been obvious to one of ordinary skill in the art at the time of the invention to render any window in any location. Even assuming, arguendo, that this is true, this does not compensate for the deficiencies of the Merriman patent with respect to claims 13 and 54 acknowledged by Examiner Rimell during the telephone interview. Consequently, these claims are not rendered obvious by the Merriman patent. Thus, the applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

Claims 33, 34, 39-41, 74, 75 and 80-82 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Merriman patent in view of U.S. Patent No. 6,892,354 ("the Servan-Schreiber patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The previous Examiner conceded that the Merriman patent does not teach that the act of submitting a

request for at least one content-relevant ad to the content-relevant ad server occurs before a request for the requested document. (See Paper No. 20050722, page 8.) In an effort to compensate for this admitted deficiency of the Merriman patent, the previous Examiner cited column 3, line 56-67 of the Servan-Schreiber patent as teaching submitting an ad request before a request for a document. The previous Examiner concluded that it would have been obvious to submit a request for ads before the document request in the Merriman patent because doing so would keep the user interested in the document or Website while the Website is downloading. (See Paper No. 20050722, page 9.)

First, even assuming, *arguendo*, that the Servan-Schreiber patent includes the purported teaching, and further assuming, *arguendo*, that one skilled in the art would have been motivated to combine the references as proposed by the previous Examiner, this combination does not compensate for the deficiencies of the Merriman patent with respect to claims 13 and 54 acknowledged by Examiner Rimell during the telephone interview. Consequently, these claims are not rendered obvious by the Merriman and Servan-Schreiber patents for at least this first reason. Thus, the applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

Second, referring to column 3, lines 28-37 of the Merriman patent, since the document of an affiliate includes the link to the ad server, the ad request can not be sent before the document is both requested and received. Thus, the modification proposed by the previous Examiner -- under which an ad request is sent

RECEIVED
CENTRAL FAX CENTER
MAY 20 2008


before a document request -- would likely render the Merriman patent inoperable, and one skilled in the art would therefore not have been motivated to combine the references as proposed. Consequently, these claims are not rendered obvious by the Merriman and Servan-Schreiber patents for at least this second reason. Thus, the applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

Conclusion

In view of the foregoing amendments and remarks, the applicant respectfully submits that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

Respectfully submitted,

August 10, 2006


John C. Pokotylo, Attorney
Reg. No. 36,242
Tel.: (732) 542-9070

CERTIFICATE OF MAILING under 37 C.F.R. 1.8(a)

I hereby certify that this correspondence is being deposited on August 10, 2006 with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


John C. Pokotylo

36,242
Reg. No.